

In the Office Action, it is asserted that claims 1-13, drawn to a container, and claims 14-17, drawn to a method for making a container, are separate inventions because the container as claimed can be made by other methods. In particular, the Examiner asserts that the container can be made by e.g., (1) mechanically attaching the outer portion without need of injection resin, (2) the inner and outer portions can be made separately and attached together (the same method as (1) above) or (3) the bottle can be positioned inside the mold cavity while the injection process only covers part of the bottle.

Applicants respectfully disagree with the assertion in the Office Action. As recited in claim 1, the container is made by 'over-molding'. Claim 1 clearly recites "a resin body *over-molded* about the first bottle..." (page 12, line 9, emphasis added). Over-molding is a well known process by which one portion of a structure is molded in place (*in situ*) to another. The Office Action cites 3 examples of 'other methods' by which the container may be made. The first 'other method' suggested by the Office Action, i.e., mechanically attach the outer portion without the need of injection resin, does not appear to involve over-molding or molding *in situ*. The second 'other method' suggested by the Office Action, i.e., inner and outer portions made separately and attached together, clearly does not involve over-molding. In fact, 'other methods' 1 and 2 cited in the Office Action appear to be essentially the same method, i.e., mechanically attaching separately made components. In contrast, claim 1 calls for the resin body to be "over-molded about the first bottle", i.e., the resin body is molded *in situ* about the first bottle.

Interestingly, the third 'other method' suggested by the Office Action (i.e., the bottle can be positioned inside the mold cavity while the injection process only covers part of the bottle) appears to be the exact method for making the container described in the specification and recited in the present claims. The third 'other method' only calls for the process to cover part of the bottle. Both the specification and the claims of the present application call for the resin body to be over-molded about the first bottle *such that at least the distal end of the neck of the bottle protrudes*. This clearly indicates that the injection process only covers part of the bottle, such that at least a small portion is exposed. Certainly as claimed and described, more than just the distal end of the neck may be exposed.

Thus, contrary to the assertion in the Office Action, it is respectfully submitted that the container recited in claim 1 with a resin body over-molded about a first bottle cannot be made by other methods. Because the container recited in claims 1-13 cannot be made by methods other than that recited in claims 14-17, the container and the method for making it are not two inventions distinct, one from the other. Accordingly, the container and the method are one invention that should be examined together. It is respectfully submitted that claims 1-13 and 14-17 should be examined as one invention in a single application.

In the Office Action, it is asserted that no claim is generic and that Applicants must select from one of a species designated by the Examiner as Group I (Figs. 1-3), Group II (Figs. 5-6), Group III (Fig. 7) and Group IV (Fig. 8).

Applicants respectfully traverse the above assertion and submit that claim 1 is generic and representative of Group I (Figs. 1-3). Claims 2-10 and 12, which depend from and include all of the recitations of claim 1, are also representative of Group I (Figs. 1-3). Furthermore, claims directed to the species designated as Group II (claim 13, Figs. 5-6), Group III (claim 11, Fig. 7) and Group IV (also claim 13, Fig. 8) are written in dependent form and include all of the limitations of claim 1.

In order to restrict prosecution to claims of a particular species, MPEP 80604(f) requires that the claims have mutually exclusive characteristics. The Office Action fails to indicate which characteristics of claim 1 are mutually exclusive to claims 11 and 13 as required by MPEP 80604(f).

In fact, claim 1 (Figs. 1-3, Group I) does not recite mutually exclusive characteristics to claim 11, directed to the species represented by Fig. 7 (Group III). Claim 1 also does not recite mutually exclusive characteristics to claim 13, directed to the species represented by Figs. 5-6 and 8 (Group II and III). Because, as required in order to restrict by MPEP 80604(f), claim 1 does not recite mutually exclusive characteristics to either claim 11 or claim 13, the restriction with respect to Group II, Group III and Group IV is traversed. It is respectfully submitted that claims 11 and 13 directed to Group II, Group III and Group IV should be prosecuted as part of this application along with claims directed to Group I (claims 1-10 and 12, Figs. 1-3).

The embodiment of Group I shown in Figs. 1-3 has a bottle 4 with a neck 12 and a resin body 6. As noted above, independent claim 1 and claims 2-10 and 12, which depend from and include all of the recitations of claim 1, are representative of Group I. Group II (claim 13) shown in Figs. 5-6 also has a bottle 4 with a neck 12 and a resin body 6. In addition, Group II has a second bottle 44 with a neck 45 in the resin body 6. Thus, while the Group II embodiment of Figs. 5-6 has additional elements, it does have all of the elements of the Group I embodiment shown in Figs. 1-3. Thus, the Group I and Group II embodiments are not mutually exclusive. Similarly, the Group III embodiment shown in Fig. 7 has a bottle 4, a neck 12 and resin body 6. The Group III embodiment has additional elements (clearances 75), but it includes all of the elements of the Group I embodiment. Accordingly, the Group I and Group III embodiments are not mutually exclusive. Finally, the Group IV embodiment shown in Fig. 8 includes an additional bottle 44 and neck 45, but it also has all of the elements of the Group I embodiment. Thus, the Group I and Group IV embodiments are not mutually exclusive. As noted above, claim 1 (Group I) is generic to all of the embodiments. Claims 2-10 and 12 (Group I), claim 11 (Group III) and claim 13 (Groups II and IV) are written in dependent form and include all of the limitations of claim 1. Accordingly, while the embodiments may be different species, the species are not mutually exclusive as required for restriction by MPEP 806.04(f). Accordingly, the embodiments shown in Figs. 5-8 should be prosecuted in the present application along with the embodiment shown in Figs. 1-3.

Applicants reserve the right to file division, continuation and continuation-in-part applications to prosecute any inventions or species held by the Examiner to be non-elected.

Submitted concurrently herewith is an Associate Power indicating a change in the attorney of record and a change in the correspondence address for the above-identified application. It is respectfully requested that the changes requested in the Associate Power be entered in the records of the Office.

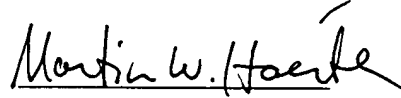
No fee is believed to be due in connection with this election with traverse. However, if a fee is required, the Commissioner is authorized to charge Deposit Account No. 05-1320.

If there are any other issues remaining which the Examiner believes could be resolved through telephone contact, the Examiner is respectfully encouraged to call the undersigned at the telephone number indicated below.

August 23, 2002

Estee Lauder Companies  
125 Pinelawn Road  
Melville, New York 11747  
631-531-1195

Respectfully submitted,

A handwritten signature in cursive script, reading "Martin W. Haerter". The signature is written in dark ink and is positioned above the printed name and title.

Martin W. Haerter, Esq.  
Reg. No. 37,842  
Attorney for Applicant